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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,360	08/09/2001	Nicholas Webb	3036/49686	5293

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EXAMINER

MENGISTU, AMARE

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,360

Applicant(s)

WEBB ET AL.

Examiner

Amare Mengistu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 33 and 34 are rejected under 35 U.S.C. 112 first paragraphs, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide support for new limitation to claims 33 and 34 as originally filed “***embedding a predetermined acoustic signal within a sound tack to be transmitted to an entertainment device***”; “***transmitting the sound track to the entertainment device***”; “***emitting the acoustic signal to the entertainment device***”; “***wherein the entertainment device comprises on of: a cinema system***”. The disclosure as originally filed has failed to disclose or teach one skill in the art how to make or use how to embed or transmit an acoustic signal to an entertainment device.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 21,23,25,27-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Tognazzini (5,708,478)** (see, figs.1, 2, 6 and 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 22,24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tognazzini (5,708,478)** in view of **Robbins et al (6,147,713)** and **William Cross land (GB 2 149 554)**.

As to claims 22,24,26, **Tognazzini discloses** broadcasted commercial display device, but has failed to disclose having analog to digital converter including specific integrated circuit and a programmable digital processor.

Robbins et al (hereinafter **Robbins**) clearly teaches it is well known for display device to have A/D converter, specific integrated circuit and a programmable digital processor (see, col.3, lines 1-4, lines 14-25; col.4, lines 53-55).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to combine the A/D converter, specific integrated circuit and a programmable digital processor of **Robbins** in to the system of **Tognazzini** because this is advantageous to provide such a converter that is economical to produce using a low cost very large scale integration application specific integrated circuit to provide the majority of the converter functions (see, col.2, lines 37-41).

Tognazzini as modified by **Robbins** has also failed to teach that the display is an LCD and the device includes a microphone and a battery. **William Cross land** (hereinafter **Cross land**) is cited to teach that it is conventional for information display device to be LCD type (see, Abstract; page 1, col.1, lines 35-41) and the electronic device also use a battery (page 1, col.2, lines 114-118). It is obvious that the devices of **Cross land** (figs. 6,7, and 9) have a microphone.

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Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have incorporated the LCD, microphone and the battery system of **Cross land** in to the device of **Tognazzini** because this will allow the **Tognazzini's** device to have a better picture quality and also provide to be a portable device.

Response to Arguments

9. Applicant's arguments with respect to claims 21-34 have been considered but are moot in view of the new ground(s) of rejection.

As to the U.S.C. 112 first paragraph rejection the Applicant assumes that the specification provide support for the recitation of claims 33 and 34. However; the Examiner strongly disagrees with Applicant's assertion, because none of the cited paragraphs disclose the recited claim limitations such as "*embedding a predetermined acoustic signal within a sound tack to be transmitted to an entertainment device*"; "*transmitting the sound track to the entertainment device*"; "*emitting the acoustic signal to the entertainment device*"; "*wherein the entertainment device comprises on of: a cinema system*".

On the last line of page 13 and on the first paragraph of page 14, the Applicant's states that "***Tognazzini** provides neither for reception and detection of an acoustically propagated signal, nor the detection of a predetermined signal*".

Applicant is directed to look at figure6 of **Tognazzini** for the above claims recitation.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare Mengistu whose telephone number is (703) 305-4880. The examiner can normally be reached on M-F, T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.


Amare Mengistu
Primary Examiner
Art Unit 2673

A.M

May 28, 2004